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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,438	10/21/2003	Minh Tran	OP-07-1	3709

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EXAMINER

PHILOGENE, PEDRO

ART UNIT	PAPER NUMBER
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3733

NOTIFICATION DATE	DELIVERY MODE
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08/22/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

intel_prop@arthrocare.com

Office Action Summary

Application No.

10/690,438

Applicant(s)

TRAN, MINH

Examiner

Pedro Philogene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-12, 16 and 18-26 is/are pending in the application.
- 4a) Of the above claim(s) 2, 4, 19, 20 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 6-12, 16, 18, 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Election/Restrictions

Newly submitted claim 26 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 26 belongs to Group II which was withdrawn from further consideration in paper submitted 8/4/05.

Claim 16 is part of the non-elected claims of Group II.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 26 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4,6-12,16, 18-25 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S.

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Patent No. 6,652,561. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is clear that all the elements of claims 1-4, 6-12, 16, 18-25. The difference between claims of the application and claims of the patent lies in the fact that the patent claims include many more elements and are thus much more specific. Thus the invention of claims 1-21 of the patent is in effect a "species" of the "generic" invention of claims 1-4, 6-12, 16, 18-25. It has been held that the generic invention is "anticipated" by the "species". See *in re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims of the application are anticipated by claims of the patent, they are not patentably distinct.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Papay et al. (6,517,542) in view of Thal (5,891,168).

With respect to claim 1, Papay et al disclose a bone anchor device (40) comprising an anchor body (42) comprising a longitudinal axis extending from a proximal end and a distal end, the anchor body having a size suitable for being inserted into bone tunnel or passageway drilled in a human bone; at least three suture retaining apertures (74) (capable of being used as suture retaining apertures) axially spaced

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along the axis in the anchor body such that a distance along the longitudinal axis is present between adjacent suture retaining aperture, each of the suture retaining apertures extending through the anchor body wherein the suture retaining aperture extend in a direction substantially transverse to the longitudinal axis; and a bone securing structure (48) for securing the anchor body in bone.

With respect to claims 3, 6-12, Papay et al disclose all the limitations; as set forth in column 2, lines 30-67, column 3, lines 1-67, column 4, lines 1-67, column 5, lines 1-67; and as best seen in FIGS. 1-25.

It is noted that Papay et al did not teach of a bone securing structure comprising a first radially narrow profile orientation and a second radially large profile orientation; as claimed by applicant. However, in a similar art, Thal, column 4, lines 5-17, evidences the use of a bone securing structure with such a profile to facilitate the attachment of the anchor to the bone.

Therefore, given the teaching of Thal, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Papay et al., as taught by Thal to facilitate the attachment of the anchor to the bone.

Claims 16, 18, 21-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (5,693,060) in view of Thal (5,891,168).

With respect to claim 16, Martin discloses a bone anchoring device for attaching connective tissue to bone, comprising an anchor body (1) comprising two surfaces (4,5) and made from material that is compatible with the human body and suitable for implantation in the human body; a suture retaining aperture (3) disposed in the anchor

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body and extending through both of the surfaces; as best seen in FIG.4; and a length of suturing material (20) extending through the suture retaining apertures (3) wherein the suture material is a material that is compatible with human body and suitable for implantation in the human body wherein the length of suturing material is looped; as best seen in FIG.4 about said anchor body and contacts substantial portions of both of the two surfaces and wherein a first portion of the length of suturing material is looped over a second portion of the length of suturing material; as best seen in FIGS.4-7, the second portion of which lies in contacting engagement with one of the surfaces of the anchor body; as best seen in FIGS.4-7.

With respect to claims 18, 21-24, Martin discloses all the limitations; asset forth in column 2, lines 17-67, column 3, lines 1-67; column 4, lines 1-67, column 5, lines 1-67, column 6, lines 1-49; and as best seen in FIGS.1-7.

It is noted that Martin did not teach of a bone securing structure comprising a first radially narrow profile orientation and a second radially large profile orientation; as claimed by applicant. However, in a similar art, Thal, column 4, lines 5-17, evidences the use of a bone securing structure with such a profile to facilitate the attachment of the anchor to the bone.

Therefore, given the teaching of Thal, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Martin, as taught by Thal to facilitate the attachment of the anchor to the bone.

Response to Amendment

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Applicant's arguments, see Remarks, filed 5/29/07, with respect to the rejection(s) of claim(s) 1,3,6-12,16,18,21-24 under 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Thal.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene
August 16, 2007


PEDRO PHILOGENE
PRIMARY EXAMINER